

*Ce*



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*[Signature]*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/294,461    04/19/99    ADAMS

B    S012-3653

EXAMINER
----------

TM02/0313

BRUCE L ADAMS  
ADAMS & WILKS  
50 BROADWAY 31ST FLOOR  
NEW YORK NY 10004

THOMPSON JR. F	
ART UNIT	PAPER NUMBER

2165  
DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/294,461

Applicant(s)

ADAMS et al.

Examiner

Forest Thompson Jr.

Group Art Unit

2165



☒ Responsive to communication(s) filed on 12/11/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2765

### DETAILED ACTION

1. Claims 1-26 have been examined.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper No. 4). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
3. This action is responsive to the amendment (amendment A) filed 11 December 2000 (see Paper #6). Amendment A amended claims 1, 9 and 10, and added new claims 14-26. **Claims 1-26 are pending.**

### *Drawings*

4. The drawings filed on 04/19/99 are acceptable subject to correction of the informalities indicated on the "Notice of Draftsperson's Patent Drawing Review," PTO-948, in the First Action (see Paper #4). Correction is required.

### *Specification*

5. The abstract was objected to in the First Action (see Paper #4) as being too long. See 37 CFR 1.72. Applicant has deleted the old abstract and submitted a new abstract. Examiner withdraws the objection to the abstract.

Art Unit: 2765

6. The abstract of the disclosure is objected to because of the structure of the first two sentences. The new Abstract states "computer. a link is established" on line 3. Examiner's amendment was accomplished which changed the Abstract to read "**computer[.], a link is established**" on line 3 (emphasis added in this paper for clarity only). This amendment was approved by Bruce Adams (applicants' representative) on 02/14/2001.

*Claim Rejections - 35 USC § 112*

7. Claim 1 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants amended claim 1 and corrected the claim language. Therefore, examiner withdraws the rejection

*Claim Rejections - 35 USC § 102*

8. Claims 1-2, 4-6, and 12 were rejected under 35 U.S.C. 102(e) as being anticipated by **Gregory** (U.S. Patent No. 5,909,673). Based on applicants' amendment, examiner has revised the rejection.

*Claim Rejections - 35 USC § 103*

Art Unit: 2765

9. Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Katz et al.** (U.S. Patent No. 6,055,513). Based on applicants' amendment, examiner has revised the rejection.

10. Claims 7-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673). Based on applicants' amendment, examiner has revised the rejection.

11. Claims 9, 10, and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Burke** (U.S. Patent No. 5,848,399). Based on applicants' amendment, examiner has revised the rejection.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Jovicic et al.** (U.S. Patent No. 5,855,007). Based on applicants' amendment, examiner has revised the rejection.

13. Claims 1-2, 4-8, 12-15, 17-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "**ZIP**

Art Unit: 2765

**COUPONS**”), and further in view of **Storey** (U.S. Patent No. 5,774,870), and “Excite Reports First Quarter 1999 Results,” PR Newswire, 15 April 1999 (hereafter referred to as **Excite**).

As per claim 1, **ZIP COUPONS** (at pg. 1, para. 2) discloses:

- a plurality of consumer units operated by a consumer;
- communications means connectable over a communication medium to at least a coupon server; a user input device to permit a consumer to make one or more choices displayed on the display monitor; a coupon server located remotely from the consumer units, comprising:
  - a memory for storing first data corresponding to one or more participating retail outlets including data for identifying each of the retail outlets by name and inventory of goods offered for sale, and second data containing coupon data used for generating electronic discount coupons for selected goods;
  - a data processing unit having communication means connectable over the communication medium to the consumer units;
  - first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first rule containing a list of participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit;
  - second means responsive to the selection of a retail outlets displayed on the display monitor of the respective consumer unit by the consumer to transmit to the respective

Art Unit: 2765

consumer unit a second file containing first data corresponding to the selected retail outlet for display on the display monitor of the consumer unit, the second file containing the identity of goods offered for sale by the selected retail outlet, and the displayed goods being individually selected by the consumer using the user input device; and

-- third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the consumer unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods.

**ZIP COUPONS** disclose that advertisers will pay Internet Infinity, Inc for placement of their zip coupons on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of the participating retail outlets are displayed on the display monitor of the consumer unit. However, **ZIP COUPONS** does not explicitly show the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available, it is discloses in **Storey** (see col. 3 lines 7-60. It would have been obvious to one skilled in the art at the time the invention was made to combine **ZIP COUPONS** and **Storey** to disclose a list of participating retail outlets in such a manner that the retail outlets are individually selectable by the consumer and transmitting a list of goods for which discount coupons are available in order to view and select products available by the individual retail outlet. When coupons are selected for each of the participating

Art Unit: 2765

stores as disclosed in **ZIP COUPONS**, products and retail stores are individually selected by the consumer.

Additionally, **EXCITE** discloses that consumers are able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests. It would have been obvious to one skilled in the art at the time the invention was made to combine **ZIP COUPONS**, **Storey** and **EXCITE** to disclose a list of participating retail outlets in such a manner that the retail outlets are individually selectable by the consumer and transmitting a list of goods for which discount coupons are available in order to view and select products available by the individual retail outlet. When coupons are selected for each of the participating stores as disclosed in **ZIP COUPONS** and **EXCITE**, products and retail stores are individually selected by the consumer.

As per claim 2, **ZIP COUPONS** discloses means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto; selecting one or more participating retail outlets in the vicinity of the consumer unit; and downloading for display on the display monitor of the consumer unit the first file containing a list of the selected retail outlets (pg. 1 para. 2).



Art Unit: 2765

As per claim 4, **ZIP COUPONS** discloses means for transmitting a file to the consumer unit containing a form (pg. 1 para. 2), where customers select the U.S. Postal zip code area where they want to shop.

As per claim 5, **ZIP COUPONS** discloses a hardcopy apparatus for producing a hardcopy of electronic coupons transmitted to the consumer unit (pg. 1 para. 2), where the customer can print out the desired coupons.

As per claim 6, **ZIP COUPONS** discloses a printer connected to a consumer unit (pg. 1 para. 2), where the customer can print out the desired coupons

As per claim 7, **ZIP COUPONS**, **Storey**, and **EXCITE** do not explicitly disclose a point-of-sale unit located in a participating retail outlet, nor a hardcopy apparatus. However, Official Notice is taken that it was old and well known at the time the invention was made that userstations or terminals for consumers' use were made available at participating retail outlets, e.g., in kiosks. Here, consumers may search for information on goods and products sold by the participating retail outlet and print coupons, as desired. Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that a computer typically is comprised of a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit; a hardcopy apparatus, and a user input device.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **ZIP COUPONS**, **Storey**, **EXCITE** and old and well known art to disclose a

Art Unit: 2765

point of sale unit comprising a hardcopy apparatus, a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit, a hardcopy apparatus, and a user input device, because this configuration provides functionality that is necessary for the invention to operate.

As per claim 8, **ZIP COUPONS** discloses:

- the coupon server is located remotely from the point-of-sale unit (pg. 1 para. 2), and further comprises:
- means for transmitting to the point-of-sale unit a fourth file containing the identity of coupons for goods offered for sale by the retail outlet at which the point-of-sale unit is located (pg. 1 para. 2); which infers that goods for sale are identified by the list of coupons available.

**ZIP COUPONS**, **Storey**, and **EXCITE** do not explicitly disclose the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods. However, **ZIP COUPONS** does disclose the user selecting a postal ZIP code area where they want to shop (i.e., which can be remote from the coupon server), selecting coupons to be provided to the user from a displayed list of coupons for a coupon interest category selected by and displayed to the user, for goods that the user is interested in purchasing (pg. 1 para. 2). Therefore it would have been obvious to one skilled in

Art Unit: 2765

the art at the time the invention was made to use the methods of **ZIP COUPONS** in combination with **Storey**, and **EXCITE** to disclose the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, because this would provide the user with the coupons provided by selected merchants for the purchase of their products, thus encouraging shopping at their establishments.

As per claim 12, **ZIP COUPONS** discloses one or more consumer units comprise client computers on a network (pg. 1 para. 2).

As per claim 13, **ZIP COUPONS** discloses the coupon server comprises an Internet host computer.

Claim 14 is written as a method and contains essentially the same limitations as claim 1; therefore, the same rejection is applied.

Claim 15 is written as a method and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 17 is written as a method and contains essentially the same limitations as claim 4; therefore, the same rejection is applied.

Claim 18 is written as a method and contains essentially the same limitations as claim 5; therefore, the same rejection is applied.

Art Unit: 2765

Claim 19 is written as a method and contains essentially the same limitations as claim 6; therefore, the same rejection is applied.

Claim 20 is written as a method and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 21 is written as a method and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 24 is written as a method and contains essentially the same limitations as claim 14; therefore, the same rejection is applied.

Claim 25 is written as a method and contains essentially the same limitations as claims 1 and 14; therefore, the same rejection is applied.

Claim 26 is written as a method and contains essentially the same limitations as the combination of claims 12 and 13; therefore, the same rejection is applied.

14. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS,” PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as “**ZIP COUPONS**”), and further in view of **Storey** (U.S. Patent No. 5,774,870), “Excite Reports First Quarter 1999 Results,” PR Newswire, 15 April 1999 (hereafter referred to as **Excite**), and further in view of **Katz et al.** (U.S. Patent No. 6,055,513).

Art Unit: 2765

As per claim 3, **ZIP COUPONS** discloses the communication medium comprises a public telephone network (col. 8 lines 2-7). **ZIP COUPONS** does not disclose means for acquiring caller ID data to identify the geographical location of the consumer unit. However, **Katz et al.** disclose:

- the communication medium comprises a public telephone network (col. 15 lines 38-65), and
- means for acquiring caller ID data to identify the geographical location of the consumer unit (col. 16 lines 9-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **ZIP COUPONS**, **Excite**, **Storey**, and **Katz et al.** to disclose the communication medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer unit, because this capability provides obvious and useful enhancements to the invention for the expeditious identification of callers.

Claim 16 is written as a method and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

15. Claims 9-11 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "**ZIP COUPONS**"), and further in view

Art Unit: 2765

of **Storey** (U.S. Patent No. 5,774,870), "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as **Excite**), and **Burke** (U.S. Patent No. 5,848,399).

As per claims 9-11, **ZIP COUPONS**, **Storey**, **EXCITE** do not disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, fifth means responsive to the selection of one or more items of goods by the consumer to transmit a fifth file for display on the display monitor of the consumer unit containing data identifying the aisle location in the selected retail outlet of the goods selected by the consumer, nor the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet. However, **Burke** discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description 56 can be stored in a store database 61, accessible by an indication of the store 59 which it describes (col. 4 lines 58-67; col. 5 lines 1-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **ZIP COUPONS**, **Storey**, **EXCITE**, and **Burke** to

Art Unit: 2765

disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, fifth means responsive to the selection of one or two more items of goods by the consumer to transmit a fifth file for display on the display monitor of the consumer unit containing data identifying the aisle location in the selected retail outlet of the goods selected by the consumer, and the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet, because this would allow the users or customers to more easily locate the specific items or goods that they want to purchase and will enhance customer attraction to the merchant.

Claim 22 is written as a method and contains essentially the same limitations as claim 9; therefore, the same rejection is applied.

Claim 23 is written as a method and contains essentially the same limitations as claim 10; therefore, the same rejection is applied.

### *Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065.

Application/Control Number: 09/294,461

Page 15

Art Unit: 2765

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

February 27, 2001 /FOT



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100